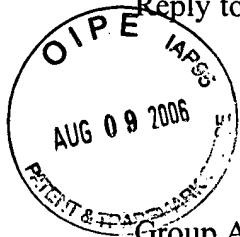


Application Serial No. 10/790,428
Request for Reconsideration dated August 2, 2006
Reply to Office Action of May 2, 2006

IFW



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Group Art Unit 3676

: PATENT APPLICATION

Examiner Mark A. Williams

: DOOR HOOK WITH
REMOVABLE SPACER

In re application of

WILLIAM E. ADAMS et al.

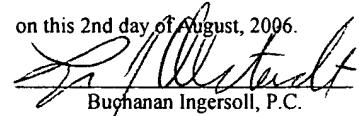
Serial No. 10/790,428

Filed March 1, 2004

I hereby certify that this
correspondence is being deposited with
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Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

on this 2nd day of August, 2006.


Buchanan Ingersoll, P.C.

REQUEST FOR RECONSIDERATION

Pittsburgh, Pennsylvania 15219

August 2, 2006

Commissioner for Patents
Post Office Box 1450
Alexandria, Virginia 22313-1450

Sir:

Applicants request reconsideration of the rejection of claims 1-8, 10, 11, 14-15, 17 and 18
in the Office Action dated May 2, 2006.

Claims 9, 12, 13 and 16 have been allowed.

The Examiner rejected claims 1, 2, 4, 6, and 7 under Section 103(a) based upon the
combination of U.S. Patent No. 3,907,118 to Pelavin in view of Published Application
2002/0144962 to Dettorre et al. This same combination with official notice that double sided
tape, adhesives and threaded members are known fasteners was cited to reject claims 3, 10 and

14. The Examiner contends that the Pelavin reference discloses all elements of the claimed invention "except for teaching the spacer portion being detachable for reattachment, as claimed." Claims 5, 15, 17 and 18 were rejected as unpatentable over the combination of Pelavin in view Dettorre and further in view of Gregory et al. U.S. Patent No. 5,515,981. These same rejections were made in the Office Action dated October 6, 2005.

In the response to the October 6 Office Action Applicants explained why the rejections were improper saying:

There is no teaching or motivation in either Dettorre or Pelavin to remove the spacer. Indeed, the references teach against the their removal. In Pelavin the thrust bearings 22 and 22' identified by the Examiner as a spacer are attached to the lugs "to prevent withdrawal." The spacer element 27 in Dettorre is provided "to maintain the panel 26 in a vertical orientation." Such orientation is required to keep the skateboard or scooter from striking the wall.

While the Examiner may be correct that the spacer 26 of Dettorre or the thrust bearings of Pelavin could be removed that is not the test for obviousness. Rather, there must be some motivation in the references to make the modification to reach the claimed invention. No such motivation is present in either of the references. Accordingly, the rejected claims are patentable over this combination.

The Examiner responded to these arguments on pages 6 and 7 of the Office Action saying:

Applicants argue that Pelavin teaches that the spacer member should not be removed. However, it is the position of the examiner that even though the particular design of the concept of Pelavin's spacer members happen to provide spacer members not intended to be removed, there is no reason why the spacer members could not be removed. Further, using alternative attaching means of the spacer members may obviously result in a removable device (see last paragraph of the specification of Pelavin). It is still believed that the device of Pelavin is not limited in scope by merely the particular attaching means shown.

Applicants argue that there is no teaching or motivation to make the spacer removable. It is the position of the examiner that one skilled in the art would

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know that various means of attaching the spacer could be used, including removable means of attachment, as known in the art of joinable elements. Dettorre obviously shows to one skilled in the art the concept of providing a removable spacer element, that could be used also in the device of Pelavin as an alternative of mounting the device.

The problem with the Examiner's position is that the reasoning does not follow the case law concerning the determination of obviousness.

The Examiner concedes that Pelavin teaches that the spacer member should not be removed. This teaching is contrary to applicants' claim of a removable spacer.

Prior art that teaches away from the method used is relevant to indicate non-obviousness. Studiengesellschaft Koahle v. Dart Industries, 216 USPQ 381, 392 (D. Del. 1982); W. L. Gore & Assoc., Inc. v. Carlisle Corp., 529 F.2d 614, 189 USPQ 129 (3rd Cir. 1976).

After reading applicants' disclosure and then reading Pelavin, the Examiner observes that "there is no reason why the spacer members [in Pelavin] could not be removable." But, Pelavin teaches that the spacer elements are not removable:

"The free ends of pintle pins 24 and 24' are capped with respective flange heads 25 and 25' to prevent withdrawal of respective thrust bearings 22 and 22' from the lugs 18 and 19 in which they are mounted." Col. 3, lines 15-18.

Having taught that the spacers are designed to prevent withdrawal, one skilled in the art would not upon reading Pelavin, recognize that the spacer member could be removable.

Second, the Examiner has used impermissible hindsight in his reading of Pelavin:

It is wrong to use patent in suit as guide through maze of prior art references, combining right references in right way as to achieve results of claims in suit; Monday morning quarterbacking is quite improper when resolving the question of non-obviousness in court of law. Orthopedic Equipment Co., Inc. et al. v. United States 217 USPQ 193, 199 (Fed. Cir. 1983) 702 F.2d 1005, 1012.

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Third, there is nothing in the last paragraph of Pelavin's specification that teaches that the spacer members could be removable. That paragraph reads:

It is also to be understood that the following claims are intended to cover all the generic and specific features of the invention herein described, and all statements of the scope of the invention which, as a matter of language, might be said to fall therebetween.

The "invention here described" has spacers which are configured "to prevent withdrawal."

The Dettorre reference is the only prior art cited by the Examiner as teaching the concept of providing a removable spacer. Applicants respectfully disagrees that Dettorre discloses a removable spacer. One stated objective of the invention disclosed by Dettorre et al. stated in paragraph 0019 as well as in the preamble to claim 1 is to provide a hanger and spacer for a skateboard or scooter for a wall mounting while maintaining the equipment away from contact with the wall. In order to accomplish that objective the spacer 27 must remain in place.

Figure 2 of Dettorre illustrates a spacer 27 and a screw used to attach the spacer to the panel 26. The Examiner infers from the drawing that spacer 27 must be removable even though the teaching of the reference is that the spacer must remain in place to achieve the desired function of the rack. Once again the Examiner has used the teaching of applicants as a guide to reading the prior art. Such a reading of Dettorre is quite improper.

Yet, another problem with the Examiner's approach is that it ignores the requirement that there must be some motivation in the references to make the claimed combination. In order for an invention to be obvious from the prior art there must be some teaching or motivation to modify the reference. W. L. Gore & Associates, Inc. v. Garlock, Inc., 220 USPQ 303, 311 (Fed. Cir. 1983). There is no teaching or motivation in either Dettorre or Pelavin to remove the spacer.

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Indeed, the references teach against their removal. Even if one views Dettorre as teaching a removable spacer there is no motivation in either Pelavin or Dettorre to combine the references. Furthermore, Pelavin's teaching that the spacer is configured to prevent removal would lead one away from modifying Pelavin to have a removable spacer.

Prior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining their teachings. In re Sernaker, 217 USPQ 1, 6 (Fed. Cir. 1983), 702 F.2d 989, 995-96.

Neither Pelavin nor Dettorre teach any advantage in providing a removable spacer. Hence, there is no motivation in the references to combine them in the way the Examiner has done.

When the cited references are viewed in accordance with the applicable case law one must conclude that the claimed invention would not have been obvious to one skilled in the art at the time the invention was made.

Reconsideration and allowance of all pending claims are respectfully requested.

Respectfully submitted,



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